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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/003,122	11/14/2001	Mike Dennis	OAE 306	5951
56703	7590	01/19/2006	EXAMINER	
ROBERT D. VARITZ, P.C. 4915 SE 33RD PLACE PORTLAND, OR 97202			KAVANAUGH, JOHN T	
			ART UNIT	PAPER NUMBER
			3728	

DATE MAILED: 01/19/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Tatch

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	10/003,122	DENNIS ET AL.	
	<b>Examiner</b>	<b>Art Unit</b>	
	Ted Kavanaugh	3728	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) Responsive to communication(s) filed on 12 December 2005.
- 2a) This action is **FINAL**.      2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) Claim(s) 7 and 8 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) Claim(s) \_\_\_\_\_ is/are allowed.
- 6) Claim(s) 7-8 is/are rejected.
- 7) Claim(s) \_\_\_\_\_ is/are objected to.
- 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) All    b) Some \* c) None of:  
1. Certified copies of the priority documents have been received.  
2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) Notice of References Cited (PTO-892)
- 2) Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.

- 4) Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) Notice of Informal Patent Application (PTO-152)
- 6) Other: \_\_\_\_\_.

## **DETAILED ACTION**

### ***Continued Examination Under 37 CFR 1.114***

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on Dec. 12, 2005 has been entered.

### ***Claim Rejections - 35 USC § 103***

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claim 7 is rejected under 35 U.S.C. 103(a) as being unpatentable over US 5319867 (Weber) in view of [pages 1-7 of PORON 90, The Ultimate in Cushioning. The Ultimate in Performance] and [PORON 4000 Performance Urethanes –90 Series – Typical Properties]. The last two references will be referred to as Rogers in the rejection below.

Weber teaches a moisture wicking fabric layer (14) having elongated fibers (20,22) and a lower foam cushioning layer (12) substantially as claimed except for the foam layer having the characteristics as claimed. Weber teaches the cushioning layer

could be made out of a plurality of different materials; see col. 4, lines 1-14. Rogers teaches an insole made out of the exact foamed Poron material used by applicant, see paragraph bridging pages 2 and 3 of the instant application. Rogers teaches "PORON 90 controlled rebound products can be fabricated and **laminated with other materials** to create unique performance composites", bold face added. It would have been obvious to construct the foam layer (12) of Weber out of the Poron foamed material, as taught by Rogers, to provide improved cushioning characteristics. The fibers inherently contribute to distributing the load. The layers as taught above will inherently perform all the functions as claimed inasmuch as they have all the structure as claimed.

***Response to Arguments***

4. Applicant's arguments filed Dec. 12, 2005 have been fully considered but they are not persuasive.

Applicant argues that "there is no teaching or suggestion in any of the PORON 90 Technical Data that the material be combined or laminated with any other material, nor used in a shoe insole".

To the contrary the PORON 90 Technical Data does teach this, "PORON 90 controlled rebound products can be fabricated and **laminated with other materials** to create unique performance composites", bold face added, page 1, col. 2. Also, see page 2, 4 and 6 wherein it specifically teaches "PORON" material used in "insole material".

Applicant argues that "PORON 90 has a compression set as measured according to ASTM Standard 1667 of less than 5%, in any of the PORON 90 Series

products" and that Weber '867 "suggest the desired compression set ranges from about 1% to about 50%, according to ASTM Standard D1667-76, and prefers a range of about 5% to about 15%" and therefore the compression set of Weber is "too low to fit within the preferred compression set parameters.

In response, Weber only teaches the preferably range is 5% to 15% but, in fact, teaches a range of 1% to 50% as noted by applicant above. Therefore Weber range does include "less than 5%".

Regarding the discussion of "spring" and "resilience," all the material in question (i.e. layer 12 of Weber and the PORON 90 material) is resilient and is "spring" to some degree. Applicant describes his material is "non-springy" since it "tends to 'creep' back toward an undeformed condition.", page 3, lines 17-18 of the instant application. The applicant could have just as easily described his material and "springy" since it does go back to its original undeformed condition. The difference is the rate or the time it takes. The facts are that both materials deflect and returned to an undeformed condition. What point makes the return rate "springy" verses "non-spring" as applicant has described is purely a matter of ones opinion.

Applicant has presented a Declaration alleging Commercial Success, on Dec. 12, 2005. However, upon review the Declaration the examiner does not find any evidence of Commercial Success. Applicant does not present any evidence that the insoles were sold, only that they were shipped and what value they represent. Moreover, even if they were all sold there is still no evidence of commercial success. There is no evidence that the commercial success alleged is directly derived from the invention

claimed, in a marketplace where the consumer is free to choose on the basis of objective principles, and that such success is not the result of heavy promotion or advertising, shift in advertising, consumption by purchasers normally tied to applicant or assignee, or other business events extraneous to the merits of the claimed invention, etc. *In re Mageli*, 470 F.2d 1380, 176 USPQ 305 (CCPA 1973) (conclusory statements or opinions that increased sales were due to the merits of the invention are entitled to little weight); *In re Noznick*, 478 F.2d 1260, 178 USPQ 43 (CCPA 1973). In ex parte proceedings before the Patent and Trademark Office, an applicant must show that the claimed features were responsible for the commercial success of an article if the evidence of nonobviousness is to be accorded substantial weight. See *In re Huang*, 100 F.3d 135, 140, 40 USPQ2d 1685, 1690 (Fed. Cir. 1996) (Inventor's opinion as to the purchaser's reason for buying the product is insufficient to demonstrate a nexus between the sales and the claimed invention.). Merely showing that there was commercial success of an article which embodied the invention is not sufficient. *Ex parte Remark*, 15 USPQ2d 1498, 1502□02 (Bd. Pat. App. & Inter. 1990). Compare *Demaco Corp. v. F. Von Langsdorff Licensing Ltd.*, 851 F.2d 1387, 7 USPQ2d 1222 (Fed. Cir. 1988). Arguments by applicant are not evidence. Mere arguments or conclusory statements in the specification or attorney remarks are not evidence.

### ***Conclusion***

5. This is a continuation of applicant's earlier Application No. 10/003122. All claims are drawn to the same invention claimed in the earlier application and could have been finally rejected on the grounds and art of record in the next Office action if they had

been entered in the earlier application. Accordingly, **THIS ACTION IS MADE FINAL** even though it is a first action in this case. See MPEP § 706.07(b). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no, however, event will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

### ***Conclusion***

6. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). Other useful information can be obtained at the PTO Home Page at [www.uspto.gov](http://www.uspto.gov).

In order to avoid potential delays, Technology Center 3700 is encouraging FAXing of responses to Office Actions directly into the Center at (571) 273-8300

**(FORMAL FAXES ONLY).** Please identify Examiner Ted Kavanaugh of Art Unit 3728 at the top of your cover sheet.

Any inquiry concerning the MERITS of this examination from the examiner should be directed to Ted Kavanaugh whose telephone number is (571) 272-4556. The examiner can normally be reached from 6AM - 4PM.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ted Kavanaugh whose telephone number is (703) 308-1244. The examiner can normally be reached on 6AM - 4PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mickey Yu can be reached on (571) 272-4562.



Ted Kavanaugh  
Primary Examiner  
Art Unit 3728

TK  
January 17, 2006